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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,167	12/29/2000	Shin Yamaguchi	36.P289	7019
5514	7590	08/10/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			OUELLETTE, JONATHAN P	
		ART UNIT	PAPER NUMBER	
		3629		

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/750,167	YAMAGUCHI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 May 2005 and 03 June 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20,22-39,41-57 and 59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20,22-39,41-57 and 59 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a) All    b) Some \* c) None of:
      1. Certified copies of the priority documents have been received.
      2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. <u>20050404</u>                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Request for Continued Examination*

1. The Request filed on 6/3/2005 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/750,167 is acceptable and a RCE has been established. An action on the RCE follows.

### *Response to Amendment*

2. Claims 21, 40, and 58 have been cancelled; therefore, Claims 1-20, 22-39, 41-57, and 59 are currently pending in application 09/750,167.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. **Claims 1-8, 15-17, 20, 22-27, 34-36, 39, 41-46, 52-54, 57, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (US 6,292,213 B1) in view of Isobe et al. (US 5,088,586).**
5. As per independent Claims 1 and 15, Jones discloses a method [computer-executable process stored on a computer-readable medium] of renting (synonymous with loaning)

removable digital storage media for use with a digital image acquisition device (C3 L8-28, loan of digital diskette for use with micro camera), the method comprising [code to process] the steps of: loaning a removable digital storage medium to a customer for insertion into a digital image acquisition device and for storage of digital image data captured by a image acquisition device; and processing the digital data stored on the returned removable digital storage medium (C10 L48-67, C11 L1-20, diskette distribution center, processing diskette data).

6. Jones fails to expressly disclose receiving, upon return of the removable digital storage medium from the customer, erasing any digital image data contained on the returned removable digital storage medium; and maintaining information associated with the loan and return of the removable digital storage medium and the customer.
7. However, Jones does disclose processing the digital data contained on diskettes (C8 L20-26, processing Center, generating still photos), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to include erasing the data on the diskette as part of the diskette processing for the purpose of recycling the diskette for future customer use.
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving, upon return, the removable digital storage medium from the customer; erasing any digital image data contained on the returned removable digital storage medium, in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the

ability to increase system efficiency and cost savings by recycling the merchandise through multiple loaning cycles.

9. Jones also discloses a rental-inventory control, allocation and accounting data handling system (C3 L5-8) for use with the micro camera rental system (C9 L16-67, C10 L1-46), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the rental system for management of the digital storage medium (diskettes) as well as the camera equipment.
10. Furthermore, Isobe discloses maintaining information associated with the loan and return of the removable digital storage medium (C7 L49-61) and the customer (C5 L1-13, Return; C7 L15-30, Rental).
11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included maintaining information associated with the loan and return of the removable digital storage medium and the customer, as disclosed by Isobe, in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase system efficiency/effectiveness by tracking the loaned assets for inventory control and loss prevention purposes.
12. As per Claim 2, Jones and Isobe disclose wherein the removable digital storage medium is lent at a first rental location (Entrance to Park) and received at a second rental location (Jones: Exit of Park – Collection site).

13. As per Claim 3, Jones and Isobe disclose wherein the first rental location and the second rental location are the same location (Jones: Front of Park, diskette distribution/processing center).
14. As per Claim 4, Jones and Isobe disclose wherein the first rental location and the second rental location are different locations (Jones: Differing entry/exit ways).
15. As per Claim 5, Jones and Isobe disclose wherein the removable digital storage medium is associated with an identification code (Isobe: C3 L19-32, article number, bar code).
16. As per Claim 6, Jones and Isobe disclose wherein the identification code associated with the removable digital storage medium is securely stored on the removable digital storage medium, and is not erased in said erasing step (Isobe: C3 L19-22, physically attached bar code).
17. As per Claim 7, Jones and Isobe disclose wherein the maintaining step further comprises assigning the identification code to the removable digital storage medium (Isobe: C3 L19-32, saving article number to database).
18. As per Claim 8, Jones and Isobe disclose wherein the maintaining step further comprises: assigning an identification code to the customer; associating the identification code of the removable digital storage medium with the identification code of the customer when the customer is lent the removable digital storage medium; and dissociating the identification code of the removable digital storage medium and the identification code of the customer when the removable digital storage medium is received from the customer (Isobe: Renting/Return Process, C4 L51-67, C5 L1-13, C7 L15-30).

19. As per Claim 16, Jones and Isobe disclose wherein the processing step further comprises making the digital data contained on the received removable digital storage medium available to the customer (Jones: C11 L1-20, Data Processing for the customer).
20. As per Claim 17, Jones and Isobe disclose wherein the processing step further comprises the steps of: transferring the digital data contained on the removable digital storage medium (generating stills – transfer to printer); and providing the other digital storage medium containing the transferred data to the customer (Jones: C11 L1-20, Data Processing for the customer).
21. As per Claim 20, Jones and Isobe disclose wherein the digital data is digital image data, and wherein the processing step further comprises printing the digital data contained on the removable digital storage medium received from the customer using an image forming apparatus (Jones: C11 L1-20, Generating Prints).
22. As per Claim 22, Jones and Isobe fail to expressly disclose wherein the processing step further comprises the step of verifying the functionality of the received removable digital storage medium.
23. However, Jones does disclose processing the digital data contained on diskettes (C8 L20-26, processing Center, generating still photos), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to include verifying the functionality of the diskette as part of the diskette processing for the purpose of recycling the diskette for future customer use.
24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the processing step further comprises the

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step of verifying the functionality of the received removable digital storage medium, in the system disclosed by Isobe, in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase system efficiency and cost savings by recycling properly operating merchandise through multiple loaning cycles.

25. As per independent Claims 23, 34, 42, and 52, Jones discloses a computer-executable process stored on a computer-readable medium [system], the computer-executable process steps to effect rental (synonymous with loaning) of a removable digital storage medium [at a first rental location] (Entrance to Park) to a customer for insertion into a digital image acquisition device and storage of digital image data captures by the digital image acquisition device (C3 L8-28, loan of digital diskette for use with micro camera) and to receive, upon return [to a second rental location] (Exit of Park), the removable digital storage medium from the customer (C10 L48-67, C11 L1-20, diskette distribution center); and a processing system for processing the digital image data on returned ones of said rented removable digital storage media (C11 L1-20, diskette processing).
26. Jones fails to expressly disclose a computer-executable process stored on a computer-readable medium for managing the rental/loan process of the digital storage medium (automation of the rental process).
27. However, It was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of managing the steps involved in

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renting digital storage medium gives you just what you would expect from the manual step as shown in Jones. In other words there is no enhancement found in the claimed step. The claimed computer-executable process only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

28. It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the management of the rental/loan process of the digital storage medium, because this would speed up the process of renting digital storage media with customers, which is purely known, and an expected result from automation of what is known in the art.
29. Furthermore, Isobe discloses an automated vending (rental/loaning) system for use with a variety of articles (abstract).
30. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to automate the steps involved in managing the rental/loan process of the digital storage medium, as disclosed by Isobe in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase system effectiveness and efficiency by speeding up the process of renting digital storage media to customers.
31. Jones also fails to expressly disclose code to erase any digital image data contained on the returned removable digital storage medium, and code to maintain information associated with the loan and return of the removable digital storage medium and the customer.

32. However, Jones does disclose processing the digital data contained on diskettes (C8 L20-26, processing Center, generating still photos), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to include erasing the data on the diskette as part of the diskette processing for the purpose of recycling the diskette for future customer use.
33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included code to erase any digital image data contained on the returned removable digital storage medium, in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase system efficiency and cost savings by recycling the merchandise through multiple loaning cycles.
34. Jones also discloses a rental-inventory control, allocation and accounting data handling system (C3 L5-8) for use with the micro camera rental system (C9 L16-67, C10 L1-46), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the rental system for management of the digital storage medium (diskettes) as well as the camera equipment.
35. Furthermore, Isobe discloses code to maintain information associated with the loan and return of the removable digital storage medium and the customer (C5 L1-13, Return; C7 L15-30, Rental).
36. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included code to maintain information associated with the loan and return of the removable digital storage medium and the customer, as disclosed

by Isobe, in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase system efficiency/effectiveness by tracking the loaned assets for inventory control and loss prevention purposes.

37. As per Claim 24, Jones and Isobe disclose wherein the removable digital storage medium is associated with an identification code (Isobe: C3 L19-32, article number, bar code).
38. As per Claim 25, Jones and Isobe disclose wherein the identification code associated with the removable digital storage medium is securely stored on the removable digital storage medium, and is not erased by said processing step (Isobe: C3 L19-22, physically attached bar code).
39. As per Claim 26, Jones and Isobe disclose wherein the maintenance system further comprises: an assignment system that assigns an identification code to the removable digital storage medium (Isobe: C3 L19-32, saving article number to database).
40. As per Claim 27, Jones and Isobe disclose wherein the maintenance system further comprises: an assignment system that assigns an identification code to the customer; and an association system that associates the identification code of the removable digital storage medium with the identification code of the customer when the customer is lent the removable digital storage medium; and dissociates the identification code of the removable digital storage medium and the identification code of the customer when the removable digital storage medium is received from the customer (Isobe: Renting/Return Process, C4 L51-67, C5 L1-13, C7 L15-30).

41. As per Claims 35, and 53, Jones and Isobe disclose wherein the processing step further comprises a producing system for making the digital data contained on the received removable digital storage medium available to the customer (Jones: C11 L1-20, Data Processing for the customer).
42. As per Claims 36; and 54, Jones and Isobe disclose a transfer system that transfers the digital data contained on the removable digital storage medium received from the customer to another digital storage medium (generating stills – transfer to printer); and a provision system that provides the other digital storage medium containing the transferred data to the customer (Jones: C11 L1-20, Data Processing for the customer).
43. As per Claims 39, and 57, Jones and Isobe disclose wherein the digital data is digital image data, and wherein the processing step further comprises a print system that prints the digital data contained on the removable digital storage medium received from the customer (Jones: C11 L1-20, Generating Prints).
44. As per Claims 41, and 59, Jones and Isobe disclose wherein the processing step further comprises the step of verifying the functionality of the received removable digital storage medium.
45. However, Jones does disclose processing the digital data contained on diskettes (C8 L20-26, processing Center, generating still photos), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to include verifying the functionality of the diskette as part of the diskette processing for the purpose of recycling the diskette for future customer use.

46. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the processing step further comprises the step of verifying the functionality of the received removable digital storage medium, in the system disclosed by Isobe, in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase system efficiency and cost savings by recycling properly operating merchandise through multiple loaning cycles.
47. As per Claim 43, Jones and Isobe disclose wherein the removable digital storage medium is associated with an identification code (Isobe: C3 L19-32, article number, bar code).
48. As per Claim 44, Jones and Isobe disclose wherein the identification code associated with the removable digital storage medium is securely stored on the removable digital storage medium, and is not erased in said erasing step (Isobe: C3 L19-22, attached bar code).
49. As per Claim 45, Jones and Isobe disclose wherein the code to maintain further comprises code to assign an identification code to the removable digital storage medium (Isobe: C3 L19-32, saving barcode info as article number).
50. As per Claim 46, Jones and Isobe disclose code to assign an identification code to the customer; code to assign the identification code of the removable digital storage medium with the identification code of the customer when the customer is lent the removable digital storage medium; and code to dissociate the identification code of the removable digital storage medium and the identification code of the customer when the removable digital storage medium is received from the customer (Isobe: Renting/Return Process, C4 L51-67, C5 L1-13, C7 L15-30).

51. Claims 9-14, 28-33, and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Isobe, and further in view of Zander (US 5,923,906).
52. As per Claim 9, 28, and 47, while Jones does disclose maintaining a global/sharing inventory system for rentable merchandise (Jones: C3 L48-67, C4 L1-11), and Isobe discloses monitoring rental merchandise by including or removing merchandise identification information from inventory (Isobe: Renting/Return Process, C4 L51-67, C5 L1-13, C7 L15-30); both Jones and Isobe fail to expressly disclose wherein the maintaining step further comprises: removing the identification code of the removable digital storage medium from inventory of the first rental location when the removable digital storage medium is lent by the first rental location to the customer; and adding the identification code of the removable digital storage medium to inventory of the second rental location when the removable digital storage device is received by the second rental location.
53. However, Zander discloses an automated vending (renting/loaning) system, which maintains, associates, and transfers merchandise identification data with vending machine identification data (C8 L27-34, C16 L32-50, C19 L34-38).
54. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the maintaining step further comprises: removing the identification code of the removable digital storage medium from inventory of the first rental location when the removable digital storage medium is lent by the first rental location to the customer; and adding the identification code of the removable

digital storage medium to inventory of the second rental location when the removable digital storage device is received by the second rental location, as disclosed by Zander, in the system disclosed by Isobe, in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase customer reach of the system, and efficiency and effectiveness of the system, by maintaining, tracking, and balancing inventories over a multitude of vending sites.

55. As per Claim 10 and 29, Jones, Isobe, and Zander disclose wherein information associated with the inventories of the first and second rental locations is stored in a data store, which is accessible by any of a plurality of rental locations (Jones: C3 L48-67, C4 L1-11, Global Inventory) (Zander: C16 L32-50, Distribution Center).
56. As per Claim 11, 30 and 48, Jones, Isobe, and Zander wherein the maintaining step further comprises the steps of: assigning the identification code of a removable digital storage medium with the identification code of a rental location when the rental location receives the removable digital storage medium; and disassociating the identification code of removable digital storage medium from the identification code of a rental location when the rental location lends the removable digital storage medium (Isobe: Renting/Return Process, C4 L51-67, C5 L1-13, C7 L15-30).
57. As per Claim 12, 31, and 49, Jones, Isobe, and Zander balancing the inventory of the first and second rental locations (Jones: C3 L48-67, C4 L1-11, Sharing Inventory).
58. As per Claim 13, 32, and 50, Jones, Isobe, and Zander the balancing step further comprising the steps of: determining a number of removable digital storage medium located at each of the first and second rental locations; and transferring removable digital

storage medium from the first rental location to the second rental location when it is determined that the first rental location has an excess number of removable digital storage medium and the second rental location has a deficient number of removable digital storage medium (Jones: C3 L48-67, C4 L1-11, Sharing Inventory).

59. As per Claim 14, 33, and 51, Jones, Isobe, and Zander the balancing step further comprising requesting a transfer of removable digital storage medium from a first rental location by a second rental location when it is determined that the second rental location has a deficient number of removable digital storage medium (Jones: C3 L48-67, C4 L1-11, Sharing Inventory).

60. **Claims 18-19, 37-38, and 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of Isobe, and further in view of Shiota et al. (US 6,337,712 B1).**

61. As per Claims 18, 37, and 55, Jones and Isobe fail to expressly disclose wherein the processing step further comprises the steps of: uploading the digital data contained on the removable digital storage medium received from the customer to a computer server; and providing the customer with access to the computer server.

62. Shiota discloses uploading digital data contained on a removable digital storage medium received from a customer to a computer server; and providing the customer with access to the computer server (C6 L30-47).

63. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the processing step further comprises the steps of: uploading the digital data contained on the removable digital storage medium

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received from the customer to a computer server; and providing the customer with access to the computer server, as disclosed by Shiota, in the system disclosed by Isobe, in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase customer service, efficiency, and effectiveness of the system, by supplying the customer with several ways to receive processed digital data.

64. As per Claims 19, 38, and 56, Jones and Isobe disclose wherein the processing step further comprises emailing the digital data contained on the removable digital storage medium received from the customer to one or more email accounts specified by the customer.
65. Shiota discloses emailing the digital data contained on the removable digital storage medium received from the customer to one or more email accounts specified by the customer (C6 L30-47).
66. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the processing step further comprises emailing the digital data contained on the removable digital storage medium received from the customer to one or more email accounts specified by the customer, as disclosed by Shiota, in the system disclosed by Isobe, in the system disclosed by Jones, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase customer service, efficiency, and effectiveness of the system, by supplying the customer with several ways to receive processed digital data.

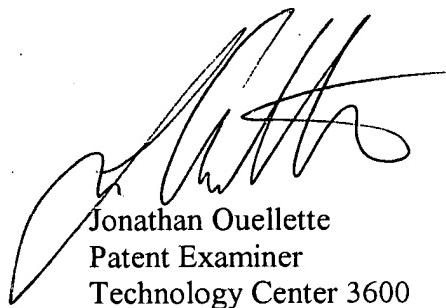
***Response to Arguments***

67. Applicant's arguments filed 5/2/2005, with respect to Claims 1-20, 22-39, 41-57, and 59, have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

68. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
69. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
70. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

August 4, 2005



Jonathan Ouellette  
Patent Examiner  
Technology Center 3600